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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/832,416	04/10/2001	Wolfgang Bartsch	7108 US	9542
66638	7590	10/19/2007		
MICHAEL A. NELSON TEKTRONIX, INC. 14150 SW KARL BRAUN DRIVE P.O. BOX 500, M/S 50-LAW BEAVERTON, OR 97077			EXAMINER DUONG, FRANK	
			ART UNIT 2616	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/832,416

Applicant(s)

BARTSCH, WOLFGANG

Examiner

Frank Duong

Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2616

DETAILED ACTION

1. This Office Action is a response to communications dated 08/16/07. Claims 1-5 are pending in the application.

Claim Rejections - 35 USC § 112

2. Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no support in the original specification for the claimed limitation of *"the specific decoder supplementing the generic decoder in realtime."*

(Note: Due to the above problem, the newly added limitation of "the specific decoder supplementing the generic decoder in realtime" is not considered on the merits. The previous rejection is maintained and explained as below)

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Yang (Protocol Compatibility Tester for CDMA Mobile Systems (CMS), IEEE, pages 96-101) (hereinafter "Yang").

Regarding **claim 1**, in accordance with Yang reference entirety, Yang shows a decoding device for analyzing communication protocols (*Figs. 2; section 2.1*) comprising:

a generic decoder (*Fig. 2; PAST Interface Controller or Lower Tester*) into which a limited number of protocol descriptions (*PDLs discussed on page 97*) are loaded, the generic decoder being adapted to interpret the protocol descriptions (*page 97*); and

a specific decoder (*Fig. 2; Machine (IBM compatible PC) or Upper Tester*) designed for a certain protocol description (*page 99, section 3.2; RS-422 or T1*), the generic and specific decoders being reversibly connected (*see Figs. 2 and 6 for connection details*).

Regarding **claim 2**, in addition to features recited in base claim 1 (see rationales discussed above), Yang further shows wherein the generic decoder comprises at least one element function (system program) that *may be* overlaid by a corresponding element function (*HD64180*) of the specific decoder (*page 99, section 3.2, it is disclosed the IBM compatible PC/486 can thus download to the HD64180 system program, which can be then be executed autonomously*).

Regarding **claim 3**, in addition to features recited in base claim 2 (see rationales discussed above), Yang further shows wherein the one overlaid element function is

Art Unit: 2616

interpreted by the generic decoder (*page 97, section 3.1, it is disclosed the PDLs designed for protocol testing*).

Regarding **claim 4**, in accordance with Yang reference entirety, Baker discloses a method of setting up a decoding device (*Fig. 2*) comprising the steps of:

provisioning a generic decoder (*Fig. 2; PAST Interface Controller or Lower Tester*) into which a limited number of protocol descriptions (*PDLs discussed on page 97*) of communication protocols are loaded, the protocol descriptions being interpreted by the generic decoder (*page 97*);

provisioning a specific decoder (*Fig. 2; Machine (IBM compatible PC) or Upper Tester*) for a certain protocol description (*page 99, section 3.2; RS-422 or T1*); and reversibly connecting the generic and specific decoders to form the decoding device so that the generic and specific decoders to form the decoding device (*see Figs. 2 and 6 for connection details*).

Regarding **claim 5**, in addition to features recited in base claim 4 (see rationales discussed above), Yang further discloses wherein the generic decoder comprises at least one element function (system program) overlaid by a corresponding element function (*HD64180*) of the specific decoder during connection of the generic decoding with the specific decoder (*page 97, section 3.1, it is disclosed the PDLs designed for protocol testing*).

Response to Arguments

4. Applicant's arguments filed 08/16/07 have been fully considered but they are not persuasive.

In the Remarks of the outstanding response, on page 5, pertaining the newly added limitation of *"the specific decoder supplementing the generic decoder in realtime,"* Applicant asserts there is support for the instant limitation on page 3, lines 16-19 and page 2, line 9. Specifically, Applicant states *"amendments do not constitute new matter because they are supported in the specification as originally filed at page 3, lines 16-19: ("The generic decoder is limited to a certain size so as not to cause runtimes of an unwanted scale, and is supplemented by the specific decoder...") and page 2, line 9 ("[Generic decoding software may cause] run times which impact realtime applications")."*

In response Examiner respectfully disagrees for the following rationales:

Applicant's assertion is rather bold, but not true. In the original specification, on page 3, lines 16-19, it does disclose (*"The generic decoder is limited to a certain size so as not to cause runtimes of an unwanted scale, and is supplemented by the specific decoder..."*) as asserted by the Applicant. However, on page 2, line 9, the original specification discusses the **background of the instant application** in general. In particular, on page 2, lines 6-9, it is disclosed *"The disadvantage of this generic decoding software approach is that the software is not as efficient as specific software adapted especially for the existing protocol. In particular the disadvantages relate to run times which impact realtime applications."* From the disclosed feature, the

claimed limitation of "*the specific decoder supplementing the generic decoder in realtime*," cannot unambiguously derive to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

For the above rationales, Applicant's remaining arguments are based on limitation not support by the original specification.

Examiner believes an earnest attempt has been made in addressing all of the Applicant's arguments. Due to the response fails to place the instant application in a favorable condition for allowance, the rejection is maintained.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Duong whose telephone number is 571-272-3164. The examiner can normally be reached on 7:00AM-3:30PM, Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynn D. Feild can be reached on 571-272-2092. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2616

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



FRANK DUONG
PRIMARY EXAMINER

October 15, 2007